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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SALMON, KATHERINE D

ART UNIT PAPER NUMBER

1634

DATE MAILED: 09/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/088,598	Applicant(s) YAMANE, AKIO	
	Examiner Katherine Salmon	Art Unit 1634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8,9 and 11-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8,9 and 11-16 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to papers filed 6/20/2006. Currently Claims 8-9, 11-16 are pending. Claims 1-7 and 10 have been canceled.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/20/2006 has been entered.
3. This action contains new grounds of rejection necessitated by amendment.

New Grounds of Objections

4. Claim 8 is objected to because of the following informalities: In line 8 "absorbs" should be changed to "absorb". Appropriate correction is required.

New Grounds of Rejection Necessitated by Amendment

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 8-9, 11-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8-9, 11-16 are unclear in regard to if the method is for detecting a nucleic acid or if it is a method for measuring energy released from the labeling substance. The preamble of Claims 8 states a method for detecting a nucleic acid. The last steps teach a method for measuring energy released from the labeling substance. Therefore it is unclear the relationship between the last step and the preamble.

Claim Rejections - 35 USC § 112- Enablement

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 8-9, 11-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Factors to be considered in determining whether a disclosure meets the enablement requirement of 35 USC 112, first paragraph, have been described by the court in *In re Wands*, 8 USPQ2d 1400 (CA FC 1988). *Wands* states at page 1404,

"Factors to be considered in determining whether a disclosure would require undue experimentation have been summarized by the board in Ex parte Forman. They include (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims."

The nature of the invention and breadth of claims

Claim 8 is drawn to a method for detecting a nucleic acid comprising contacting a probe with a energy releasing label and an energy absorbing label 0 to 1 nucleotides apart which forms a hybridized double-stranded nucleic acid wherein the hybridized probe has no quenching when attached to the target. Claim 9 is drawn to a method wherein energy released indicates the hybridization of a probe to a target. Claim 11 defines energy. Claim 12 defines the labels. Claim 13 define the energy absorbing as an intercalator. Claim 14 defines the intercalator. Claim 15 defines the labeling substance. Claim 16 is drawn to a method wherein the probe is immobilized on a solid phase.

The claims are drawn to method in which there is no quenching, but the teachings in the art illustrate different results.

The invention is in a class of invention, which the CAFC has characterized as "the unpredictable arts such as chemistry and biology." *Mycogen Plant Sci., Inc. v. Monsanto Co.*, 243 F.3d 1316, 1330 (Fed. Cir. 2001).

Guidance in the Specification

The specification asserts a method in which the energy transfer from the labeling substance to the energy-absorbing substance is intercepted by the hybridization of the probe with a target nucleic acid (p. 5 lines 1-9). The specification asserts the labeling substance and the energy absorbing substance can be placed on a position of the probe sequence including the 5' and 3' ends (p. 6 lines 36-37 and p. 7 lines 1-11). The specification asserts the more closely the two labels are arranged, the better the energy transfer efficiency can be (p. 7 lines 20-21).

The specification asserts when a probe is completely complementary to a target the intercalator binds specifically to the target resulting in no quenching of a labeling substance introduced into the probe (p. 8 lines 11-18). It is unclear from the specification the definition of "no quenching". It is unclear if "no quenching" encompasses residual quenching from the closeness of the labeling molecules and the reduction of fluorescence due to measurement (photobleaching). The specification asserts if the probe is incompletely hybridized or does not hybridize then there is quenching of the probe (p. 8 lines 19-25). The specification asserts the presence of light released from the labeling substance indicates that the probe and target are hybridized while no light indicates that the probe and the target are not hybridized (p. 8 lines 25-30).

The specification asserts that when the probe and a sample (target) do not match on a single base position, change in the structure of the resulting double stranded nucleic acid occurs and an energy absorbing substance is introduced into the probe

such that it does not interact with the double stranded nucleic acid resulting in quenching of a labeling substance introduced into the probe (p. 8 lines 30-37 and p. 9 line 1). It is unclear if incomplete hybridization would result in complete quenching.

The specification asserts acridine is intercalated in different ways depending on whether the double stranded chain is completely matched or mismatched with a single base, and thus acridine is intercalated in a completely matched double stranded chain but no intercalation occurs when a mismatch is present (p. 9 lines 8-13).

Working Examples

The specification asserts the hybridization of probes with two targets to determine quenching and nonquenching. The specification asserts 4 probes were labeled with fluorescein and pyrene wherein the intercalator and the label were between 0 to 1 nucleotides apart (p. 12 lines 21-30). Table 1 presents the fluorescent intensity of the labeled oligonucleotides in the presence of nonlabeled oligonucleotides (targets). Probe 1 (EFN1-F) in the presence of no target and in the presences of target 2 (EC2), which is a complete mismatch, shows low fluorescent intensity (quenching) (Table 1 p. 13). Probe 1 (EFN1-F) in the presence of target 1 (EC1), shows increased fluorescent intensity. It is unclear if the increased fluorescence intensity of the probes hybridized completely to the target is encompassed by the phrase "no quenching". Quenching is reduced because there is an increase in intensity but it is not clear if there is reduced quenching or complete loss of (i.e. NO) quenching. Further, no examples are provided

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for partial hybridization. It is unclear if partial hybridization would produce quenching, reduced quenching, or no quenching.

The unpredictability of the art and the state of the prior art

Shinozuka et al. (Journal Chem. Soc, Chem. Commun. 1994 p. 1377) teaches a method of labeling a DNA probe with fluorescein and acridine (p. 1377 1st column 2nd paragraph). Shinozuka et al. teaches a method in which the fluorescein and acridine molecules are on the 3' end of the DNA probe (within 0 to 1 nucleotides) (Scheme 1 p. 1377). Shinozuka et al. teaches the fluorescence intensity is strongly affected by the formation of a double strand so that the reversible association of oligonucleotides can be monitored by examining fluorescence intensity (p. 1377 Column 1 paragraph 2). Shinozuka et al. teaches the acridine moiety intercalates to base pairs of the complex of the probe and the target (p. 1378 1st paragraph). Shinozuka et al. teaches the acridine is less capable of efficient energy transfer and therefore fluorescence is reduced (p. 1378 1st paragraph). Shinozuka et al. teaches at higher temperatures the acridine frees itself from being trapped between the basepairs causing an increase in fluorescence intensity (p. 1378 1st paragraph). Shinozuka et al. teaches that at low temperatures the probe has a high measured fluorescence whereas the target-probe complex is quenched (Figure 1). Shinozuka et al. teaches at high temperatures the probe alone is quenched and the target-probe complex increases in fluorescence (Figure 1). Therefore, Shinozuka et al. teaches that the combination of target probe in regard to fluorescence intensity is temperature based. Further, Shinozuka et al. teaches that at

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low temperatures the opposite effect of the teachings of the instant specification occurs, wherein the target-probe complex is quenched.

The art teaches that acridine increases quenching. Cardullo et al. (Proc. Natl. Acad. Sci. December 1988 Vol 85 p. 8790) teaches a method of adding acridine orange (an intercalator) to a tube and then adding labeled probes and unlabeled targets (p. 8791 2nd column 2nd paragraph and Figure 1 C). Cardullo et al. teaches the intercalating acridine was used as a donor to detect hybridization between an unlabeled target and rhodamine labeled probe (p. 8792 last paragraph). Cardullo et al. teaches the degree of fluorescence quenching is enhanced by the use of acridine orange (p. 8793 1st column 1st full paragraph).

Quantity of Experimentation

The quantity of experimentation in this area would be extremely large since there is significant number of parameters that would have to be studied. To practice the invention as broadly as it is claimed, the skilled artisan would have to determine the effect of the intercalator on probe-targets at varying degrees of temperature. The skilled artisan would have to also determine if "no quenching" is complete fluorescence or increased fluorescence.

To use the invention as presented would require a large amount of inventive effort, with each of the many intervening steps, upon effective reduction to practice, not providing any guarantee of success in the succeeding steps.

Level of Skill in the Art

The level of skill in the art is deemed to be high, because it is unclear how the instant method differs from the method taught in the art which produces quenching when the probe and the target hybridize.

Conclusion

Thus the applicants have not provided sufficient guidance to enable a skilled artisan to make the claimed invention in a manner reasonably correlated with the claimed method of detecting a nucleic acid wherein "no quenching," indicates the hybridization of a probe to a target. There are examples of probes labeled with an intercalator and a fluorophore in the art that reduce fluorescence upon target hybridization. The specification provides no definition of "no quenching" and it is unclear if the examples provided have increased fluorescence with reduced quenching or if the examples provide the intensity of a probe target without any quenching effects. In light of the deficiency of the specification to define "no quenching" and the negative teaching in the art with regard to the quenching effect of hybridization of the target and the probe, the skilled artisan would be forced to practice undue and unpredictable trial and error experimentations when practicing the instant invention.

Considering the nature of the invention, the guidance provided by both the prior art and the instant specification, and the broad scope of the invention, it is clear that the skilled artisan would be required to practice undue and unpredictable trial and error experimentation to practice the invention that is claimed.

Conclusion

7. No Claims are allowable.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine Salmon whose telephone number is (571) 272-3316. The examiner can normally be reached on Monday-Friday 8AM-430PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla can be reached on (571) 272-0735. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Katherine Salmon
Examiner
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